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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,214	11/26/2003	Bruce Albrecht	ITW7510.073	1213
33647	7590	10/02/2006	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (ITW) 14135 NORTH CEDARBURG ROAD MEQUON, WI 53097			SHARP, JEFFREY ANDREW	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/707,214	ALBRECHT ET AL.	
	Examiner	Art Unit	
	Jeffrey Sharp	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

[1] This action is responsive to Applicant's remarks/amendment filed on 18 July 2006 with regard to the Official Office action mailed on 18 April 2006.

Status of Claims

[2] Claims 1-29 are pending.

Claim Objections

[3] Claim 16 is currently objected to because of informalities. There appears to be no clear antecedent basis for the limitation "the non-planar surface". The claim has been treated as definite.

Claim Rejections - 35 USC § 112

[4] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[5] Claim 27 was previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has successfully addressed the issue of indefiniteness in the amendment filed on 18 July 2006. Accordingly, the rejection of the claim under 35 U.S.C. 112, second paragraph has been withdrawn.

Claim Rejections - 35 USC § 102

[6] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

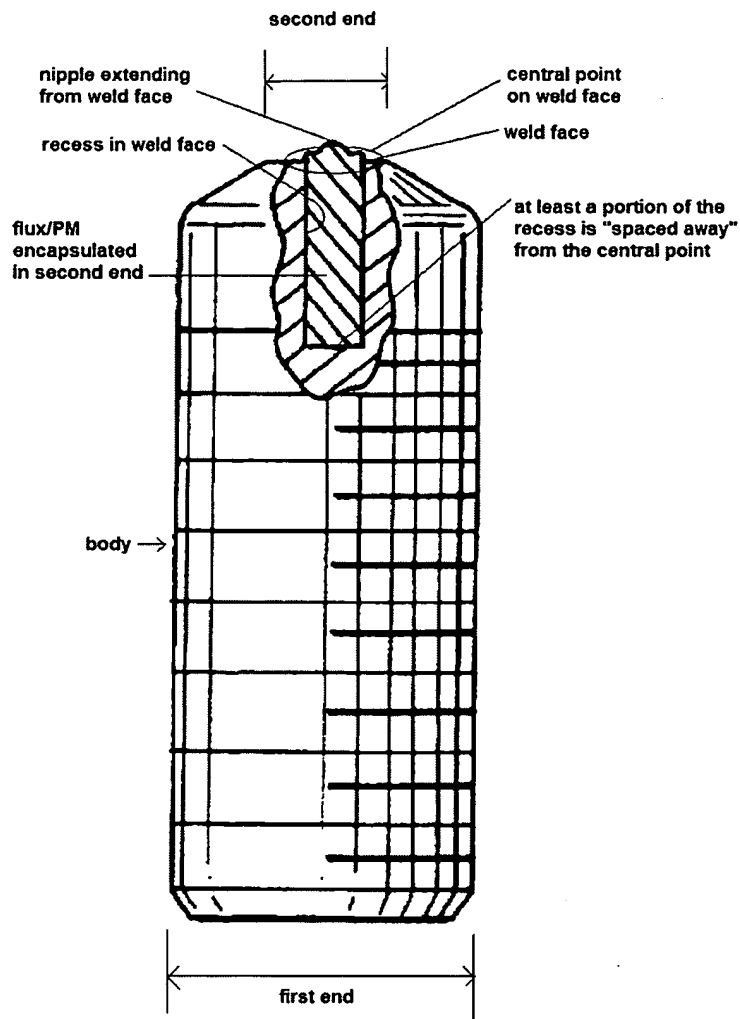
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[7] Claims 1-3, 6, 18, 19, 23-25, 27, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Duffy et al. US-5,685,680.

In its broadest sense, and when each independent claim is taken into consideration alone, Duffy et al. illustrates each and every limitation of the aforementioned claims. In short, Duffy et al. teach a welding stud comprising a first end, second end, weld face, encapsulated flux/powdered metal, and a recess in the second end. For clarity, and to expedite prosecution, the examiner has illustrated the broadest reasonable interpretation of Duffy et al. below.

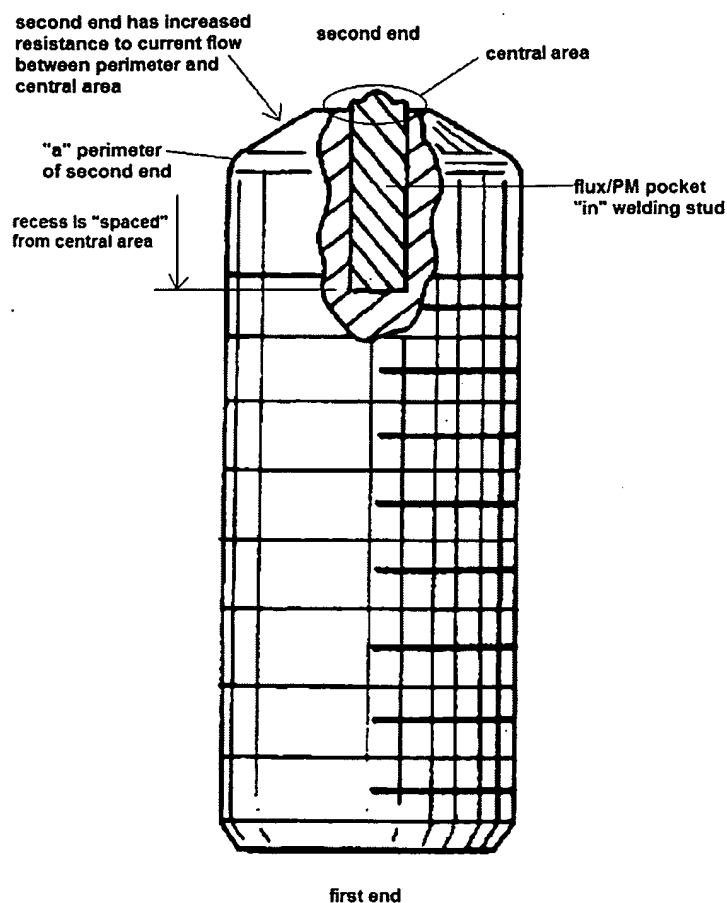
As for Claims 1-3 and 6, it is noted that Duffy et al. teach a central point, to which the recess is "*spaced (broadly) away from the central point*", since the recess bottom is axially "*spaced away*" from the central point:



The examiner does note that Duffy et al. fail to show or suggest a recess "*spaced radially away from the central point*".

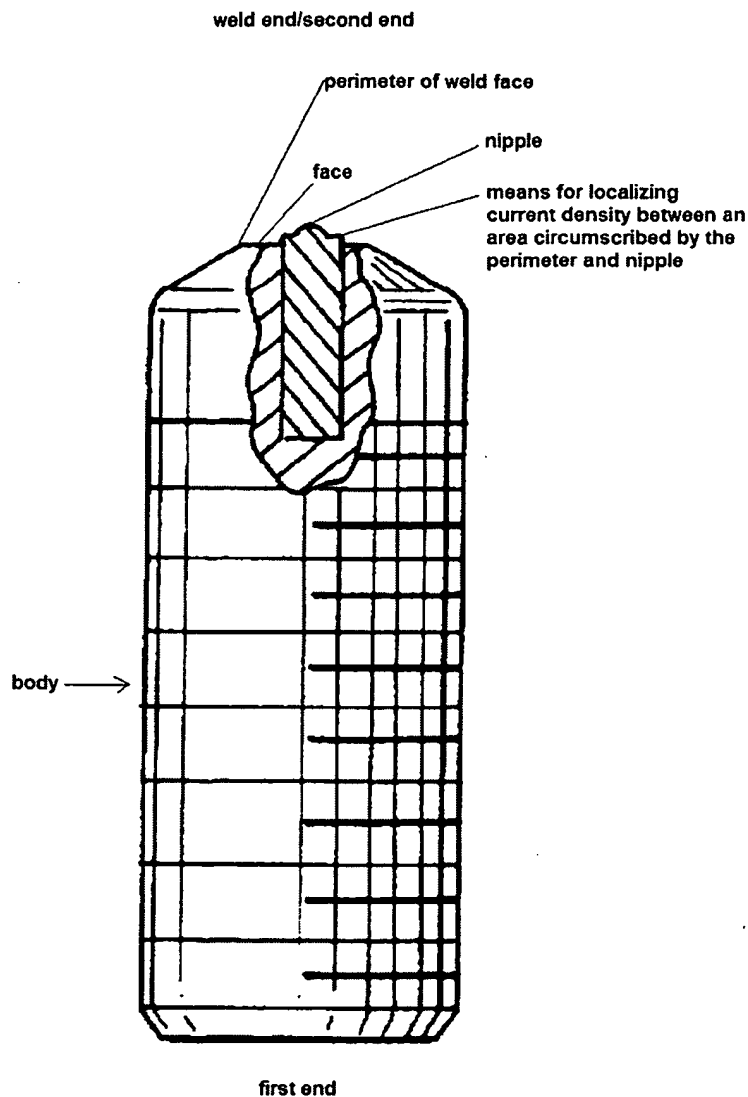
As for Claims 18, 19, 23, and 24, it is noted that Duffy et al. teach a second end having a central area, and "a" perimeter surrounding said second end. The area between the perimeter and central area has an increased resistance to current flow, as compared with a generally planar face. The welding stud has a flux/powdered metal pocket "in" it:

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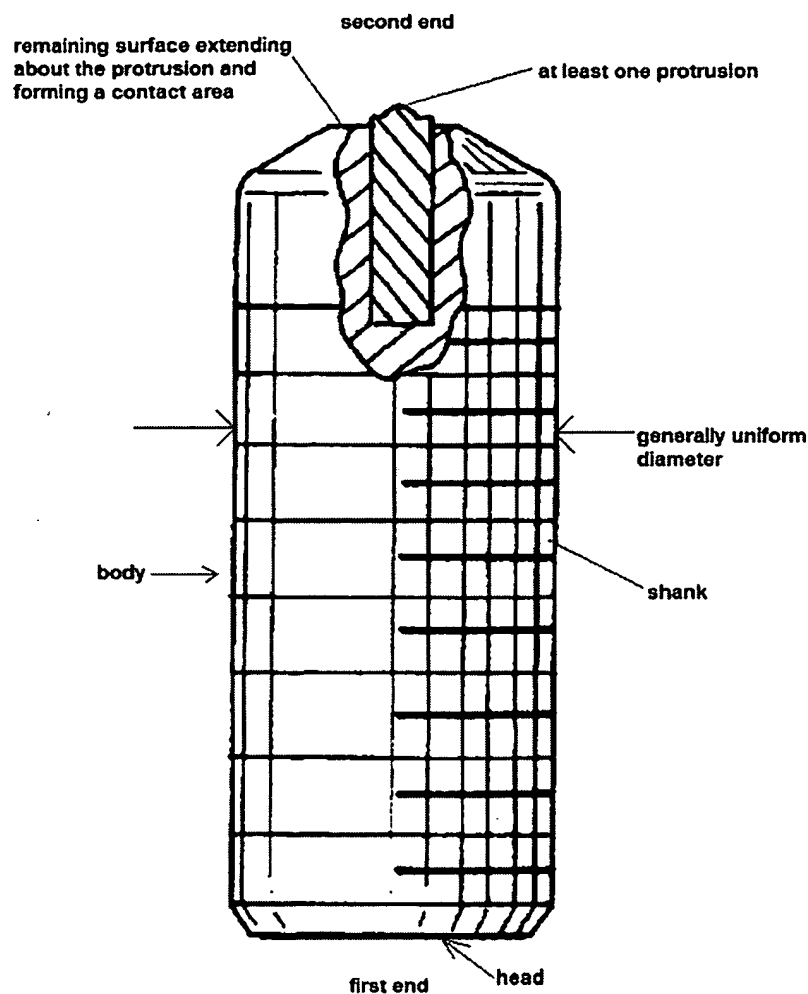


As for Claims 25, 27, and 28, Duffy et al. teach a welding stud comprising a first end, body, and a weld face having a perimeter at a weld end, which is to be entirely consumed by a welding process (intended use), said weld end having a nipple proximate an axis of the body, and said welding stud further comprising a means for localizing current density between the perimeter and nipple:

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As for Claim 29, Duffy et al. show a body having what could broadly be construed as a head on a first end, a second end, a shank extending between the two, said first end being configured to engage a welding gun (shown clearly in Figure 4), said second end having at least one protrusion, and a remaining surface extending about the protrusion that is configured with a contact area decreased compared to a planar surface. Examiner notes that a (broad) "planar surface" is undefined, and thus may be open to having any area greater than the contact area, and that "head" is not limited to "radially extending head":



[8] Claims 1-3, 4, 8-13, and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Enright US-2,788,233 (refer to Figures 5 and 6).

In short, and in its broadest reasonable sense, Enright teaches a welding stud comprising a first end (not labeled), second end (Figure 5) of reduced diameter to said first end, a body having a shank (10), and powdered metal flux (11) encapsulated in the welding stud. The second (i.e., "weld") end has a weld face that increases resistance to current, and further comprises a

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° plurality of recesses (i.e., "grooves" 19) disposed concentrically about a center point/area of said second end.

As for claims 20-22, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

[9] Claims 1-3, 4, 8-13, and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Aversten US-2,823,297.

In short, and in its broadest reasonable sense, Aversten teaches a welding stud comprising a first end (not labeled), second end (Figures 2 and 4) of reduced diameter to said first end (due to convex shape), a body having a shank (1), and powdered metal flux (2) encapsulated in the

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welding stud. The second (i.e., "weld") end has a weld face that increases resistance to current, and further comprises a plurality of recesses (i.e., "grooves" 4, 5) disposed concentrically about a center point/area of said second end.

[10] Claims 1-3, 6, 7, 18, 19, 23-25, 27, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Rondeau et al. US-3760,143.

In short, and in its broadest reasonable sense, Rondeau et al. teaches a welding stud comprising a first end (16), second end (Figure 9) of reduced diameter to said first end (due to frustoconical shape), a body (14) having a shank, and powdered metal flux (28) encapsulated in the welding stud. The second (i.e., "weld") end has a weld face that increases resistance to current, and further comprises a recess (20) spaced (e.g., "axially") from a center point/area (82) of said second end.

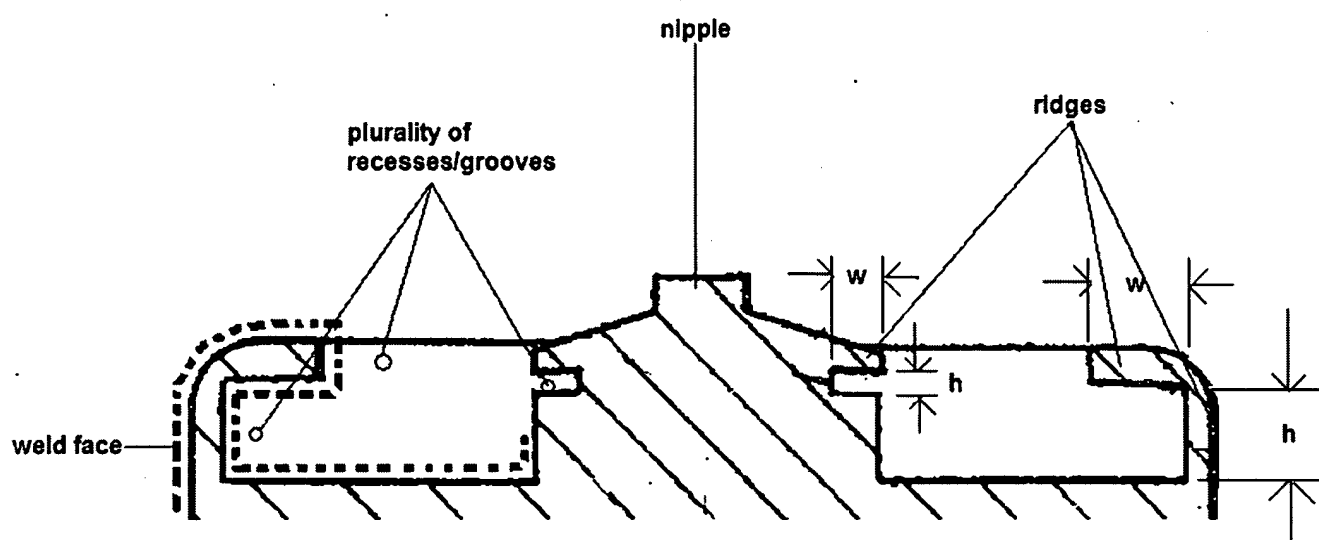
As for claim 1, the examiner does note that Rondeau et al. fail to show or suggest a recess *"spaced radially away from the central point"*.

[11] Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan US-3,253,115.

In short, and in its broadest reasonable sense, Logan teaches a welding stud comprising a first end (24) having a flange engagable with a welding gun, second end (Figure 2) of reduced diameter to said first end, a body (20) having a shank (22), and powdered metal flux (37) encapsulated in the welding stud. The second (i.e., "weld") end has a weld face that increases resistance to current, and further comprises a plurality of recesses/grooves (near 31, under 33,

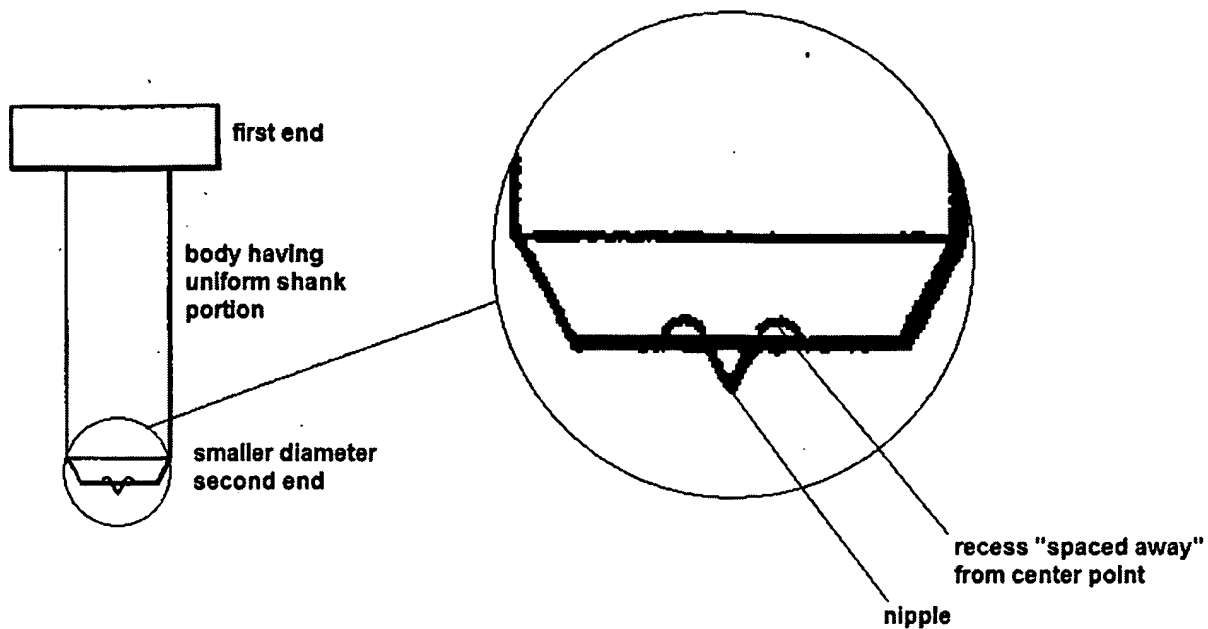
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and near 39) disposed concentrically about a center point/area of said second end. The welding stud comprises a nipple (42) aligned with the axis of the stud, which is formed from the same material, and which spaces the stud from a workpiece (88) during a welding process (Figure 8). Pertinent to claim 17, the grooves have a base and height being roughly equivalent as shown below:



Logan US-3,253,115

[12] Claims 1, 2, 6, 7, 18, 23, 24, 25, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Molyneux et al. US-3891,332.



Molyneux et al. US-3891,332

Claim Rejections - 35 USC § 103

[13] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[14] Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irimes US-5,493,833 in view of EP-1060822 (Figures j and m).

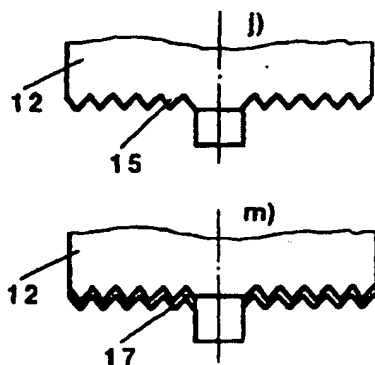
In short, Irimes teaches a welding stud having a first end having a flange and a smaller second end having a weld face and flux/powdered metal packet. The welding stud comprises a body having a solid, shank portion of generally uniform diameter. Irimes teaches a

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nipple/protrusion extending to separate the stud a distance from a workpiece during a welding process. Note that the entire second end of Irimies is to be welded.

However, Irimies fails to disclose expressly, a plurality of grooves and ridges to facilitate the welding process, in particular, said grooves being "spaced away" from a center portion of the weld end, and forming peaks, said grooves having a width and a height roughly equal to each other.

EP-1060822 suggests that it would be obvious to modify a weld end to comprise a plurality of peaks (15,17) and grooves (16) spaced from a center nipple (13) being "spaced away" from a center portion of the weld end and having a height to base width ratio of approximately one.



EP-1060822

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art, to modify the second welding stud end taught by Irimies, by employing a plurality of grooves and ridges as suggested by EP-1060822, in order to improve welding efficiency, and/or as an art-recognized equivalent to the second welding end taught by Irimies.

Response to Arguments/Remarks

[15] Claims 1-3, 6, 18, 19, 23-25, 27, 28, and 29 were previously rejected under 35 U.S.C. §102(b) as being anticipated by Duffy et al. US-5,685,680.

Applicant's arguments/remarks with regard to this rejection have been fully considered, but are not persuasive. Examiner takes the position that the recess taught by Duffy et al. is "hollow", as a recess, by definition suggests "hollow". Examiner agrees with Applicant that Duffy et al. shows the recess being occupied, but nowhere in the claims is the limitation "a recess not occupied by one of powdered metal and flux-PM combination".

Moreover, Examiner feels the claim language as currently presented is broad enough to read on the welding stud taught by Duffy et al., even after consideration of the functional language "increased resistance to current flow as compared to a welding stud having a nipple and a generally planar surface thereabout". Examiner notes that this limitation has not been given significant patentable weight, because the limitation is a comparison with an unclaimed apparatus, which is not defined. Therefore, this is considered a positive limitation having an intangible scope. The functional recitations disclosed in the claims have not been given patentable weight because they are narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 U.S.C. §112 sixth paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.C. 172; 388 O.G. 279.

With regard to the limitation "means for localizing current density between the perimeter and nipple, it would be instantly recognized and appreciated by those of ordinary skill in the art

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that the second end is configured to localize current density at least more than the first end.

While examiner agrees that perhaps *initially*, the flux packet will provide the localized current density, once the weld end makes contact with a welding surface, this limitation is satisfied.

Lastly, as for Applicant's argument for claims 28 and 29 that Duffy et al. fails to disclose a non-planar surface, the word "planar" suggests lying in the same plane. Duffy et al. has a conical or "non-planar surface" about the weld face and second end nipple, which provides a "decreased arc area". Applicant is reminded that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Examiner suggest utilizing limitations defining structure and not function in order to overcome the above prior art rejection.

[16] Claims 1-3, 4, 8-13 and 18-24 were previously rejected under 35 U.S.C. §102(b) as being anticipated by Enright US-2,788,233 Figs. 5 and 6.

Applicant's arguments/remarks with regard to this rejection have been fully considered, but are not persuasive.

After further consideration of the scope of the claims, and after reviewing the Enright reference, the examiner feels that the rejection is proper when the claims are given their broadest reasonable interpretation.

Addressing claim 10, Enright teaches a weld end having geometrically concentric grooves and ridges (14). While only one groove and ridge is illustrated, "it is understood, however, that more than one recess (14) may be used if necessary and that these recesses may be positioned other than at the center of the end (i.e., weld) surface" (col. 2 lines 22-25).

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For the same reason as described above, the limitation "hollow" in front of "recess" fails to overcome Enright, because a recess will always be or cause hollowness. While Examiner agrees with Applicant that Enright shows the recess (14) comprising grooves and ridges being occupied, nowhere in the claims does the limitation "a recess not occupied by one of powdered metal and flux-PM combination" appear.

As for Applicant's argument that Enright fails to disclose "the second end has a weld face that increases resistance to current", the Examiner takes official notice that "the larger the cross-sectional area of the conductor, the more electrons are available to carry the current, so the lower the resistance" as evidenced by the enclosed NPL. This is a well-known engineering principle, and therefore, the curved surface of the packet or the recesses (14) formed in the weld surface, which both *reduce* the cross sectional area of the weld stud, inherently increase the resistance to current flow at the second end.

As stated above for Duffy et al., comparisons with a welding stud having a nipple and generally planar surface thereabout do not further limit the scope of the claim, since such model for comparison is not positively claimed. It is suggested that the weld stud of the present invention is defined from the prior art through structural limitations and not through limitations regarding an alleged performance improvement.

Lastly, as for the process claims, it is well-known to stamp weld end features as evidenced by Ramasamy US-6,818,851 col. 1 lines 21-23. It is also well-known to etch a weld end to improve weldability of aluminum studs as evidenced by Schmitt et al. US-6,860,687 col. 2 lines 36-38. Cited Molyneux et al. US-3,891,332 further suggests it is well-known to provide such weld end features by "forging" (i.e., stamping) or "machining" col. 2 line 36. In an effort to

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expedite prosecution and reduce costs to Applicant, the Examiner has examined and grouped method claims 18-24 with product claims since those method claims generally comprise steps consistent with "providing" or "forming" particular structural elements. Should Applicant continue to argue that the method claims cannot be taught by the prior art in terms of structure alone, then those method claims will be restricted as being drawn to strictly a manufacturing process for making a fastener classified in class 470.

For at least these reasons, the above rejection is maintained.

[17] Claims 1-3, 4, 8-13 and 18-24 were previously rejected under 35 U.S.C. § 102(b) as being anticipated by Aversten US-2,823,297.

Applicant's arguments/remarks with regard to this rejection have been fully considered, but are not persuasive.

After further consideration of the scope of the claims, and after reviewing the Aversten reference, the examiner feels that the rejection is proper when the claims are given their broadest reasonable interpretation.

Again, the "hollow" limitations fails to overcome the prior art, because a recess, even when filled, is still a "hollow recess". While Examiner agrees with Applicant that Aversten shows the recess comprising grooves and ridges being occupied, nowhere in the claims does the limitation "a recess not occupied by one of powdered metal and flux-PM combination" appear. The mere fact that Aversten discloses additional structure not claimed is irrelevant.

As for Applicant's argument that Aversten fails to disclose "the second end has a weld face that increases resistance to current", the Examiner takes official notice that "the larger the

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cross-sectional area of the conductor, the more electrons are available to carry the current, so the lower the resistance" as evidenced by the enclosed NPL. This is a well-known engineering principle. Therefore, the "bulged end face 3 having its greatest height at the middle" noted by Applicant which is formed in Aversten's weld surface, *reduces* the cross sectional area of the weld stud, and therefore, inherently *increases* the resistance to current flow at the second end.

For at least these reasons, the above rejection is maintained.

[18] Claims 1-3, 6, 7, 18, 19, 23-25, 27, 28, and 29 were previously rejected under 35 U.S.C. §102(b) as being anticipated by Rondeau et al. US-3,760,143.

Applicant's arguments/remarks with regard to this rejection have been fully considered, but are not persuasive for at least the reasons stated above.

The term "hollow recess" does not suggest --unoccupied recess-- by any means. The term recess by itself, suggests "hollow". Examiner suggests amending the claims to positively recite this limitation.

As for the argument that "weld current would be concentrated at the slug or fluxing material (24) of the second end", Examiner takes the position that once the slug or fluxing material (24) taught by Rondeau et al. is melted, the remaining weld face "increases resistance to current" and "localizes current density" as would the area (128) of Applicant's embodiment in the instant Figure 12.

For at least these reasons, the above rejection is maintained.

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[19] Claims 1-29 were previously rejected under 35 U.S.C. §102(b) as being anticipated by Logan US-3,253,115.

Applicant's arguments/remarks with regard to this rejection have been fully considered, but are not persuasive for at least the reasons stated above.

The term "hollow recess" does not suggest --unoccupied recess-- by any means. The term recess by itself, suggests "hollow". Examiner suggests amending the claims to positively recite this limitation.

Regarding Applicant's opinion that "Examiner's characterization of Logan" allegedly "distorts the structure therein", Things clearly shown in reference patent drawings qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972). Examiner finds no convincing reason why Logan's plurality of grooves and ridges cannot read on Applicant's "grooves and ridges". While Examiner may agree that the figures disclosed in the present application would suggest a plurality of grooves and ridges that differ from Logan, Applicant fails to substantially limit the scope of "grooves and ridges" in claim 10 to reflect the figures of the instant application. Without further limitation or clarifying how the ridges protrude axially from the weld face and are interposed between a series of independent and unoccupied annular, concentric, radially-spaced grooves, Examiner maintains the rejection. The term "geometrically concentric" has been interpreted as "having symmetry, balance, uniformity, and/or evenness about and along the longitudinal axis", and has been treated as a rather broad term.

Regarding Applicant's arguments over "localizing current density" see above rejections.

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As for Applicant's argument that "no portion besides the nipple constitutes an arc surface area" and that "Logan fails to teach, suggest, or disclose a welding stud having a second end with a nipple and a portion thereabout having a decrease arc surface area as called for in claim 28", Examiner contends that Logan shows "a nipple (45) and a portion thereabout (43) having a decrease arc surface area.

For at least these reasons, the above rejection is maintained.

[20] Claims 1, 2, 6, 7, 18, 23, 24, 25, 28, and 29 were previously rejected under 35 U.S.C. § 102(b) as being anticipated by Molyneux et al. US-3,891,332.

Applicant's arguments/remarks with regard to this rejection have been fully considered, but are not persuasive for at least the reasons stated above.

Examiner acknowledges Applicant's concern that a rejection of the claims was made only by way of a drawing; however, things clearly shown in reference patent drawings qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972).

Applicant admits in the remarks that Molyneux et al. teaches a "projection (5)", which could be broadly construed as a "nipple". Applicant further admits in the remarks, that this projection is surrounded by an "annular groove (6)", which could be broadly construed as a "hollow recess". Therefore, Examiner feels the rejection is fair, because the limitations of the above claims are taught.

Applicant does not positively claim "an assembly comprising a metal surface for welding and a recess on a welding stud, said recess not occupied by said metal surface after welding".

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However, Applicant appears to argue that the recess taught by Molyneux et al. is not "hollow" because it fills with a metal surface upon/after welding. This argument that Molyneux et al.'s recess is "filled" by a metal sheet during welding, and so the recess is not "hollow" is entirely unpersuasive. Molyneux et al. clearly shows a "hollow" concentric recess at a second weld end, which may serve to increase the resistance to current, and localize current density.

As noted above, the Examiner feels the claim language as currently presented is broad enough to read on the welding stud taught by Molyneux et al., even after consideration of the functional language "increased resistance to current flow as compared to a welding stud having a nipple and a generally planar surface thereabout". Examiner notes that this limitation has not been given significant patentable weight, because the limitation is a comparison with an unclaimed apparatus.

For at least these reasons, the above rejection is maintained.

[21] Claims 1-29 were previously are rejected under 35 U.S.C. §103(a) as being unpatentable over Irimies US-5,493,833 in view of Franz EP 1030822 Figs. j and m.

Applicant's arguments/remarks with regard to this rejection have been fully considered, but are not persuasive for at least the reasons stated above.

In response to Applicant's question why an English translation has not been provided, the Franz EP 1030822 was submitted by Applicant on form PTO-1449, and the Examiner is relying solely on figures j and m, which need no translation. MPEP 609.05(b) [R-3] subsection "Complying Information Disclosure Statements" states: Information which complies with requirements as discussed in this section but which is in a non-English language will be

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considered in view of the concise explanation submitted (**>see MPEP § 609.04(a), subsection III.<) and insofar as it is understood on its face, e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches. The examiner need not have the information translated unless it appears to be necessary to do so. The examiner will indicate that the non-English language information has been considered in the same manner as consideration is indicated for information submitted in English. The examiner should not require that a translation be filed by applicant. The examiner should not make any comment such as that the non-English language information has only been considered to the extent understood, since this fact is inherent. See Semiconductor Energy Laboratory Co. V. Samsung Electronics Co., 204 F.3d 1368, 1377-78, 54 USPQ2d 1001, 1008 (Fed. Cir. 2000). If the Applicant deems that it is necessary to provide a translation for the reference to rebut this rejection, Examiner invites the Applicant to do so.

Since Applicant has not commented on or traversed this rejection based on merit, but rather only argues that the teaching reference is in a language other than English, the Examiner can only be led to believe, pending any further remarks, that there is no disagreement that the rejection is proper. Simply stating that the rejection is an "omnibus 35 U.S.C. §103(a) rejection" is not a bona fide response, since Applicant has not clearly and distinctly addressed how each claim defines over the prior art.

Conclusion

[22] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: See form PTO-892.

[23] If Applicant believes a telephone interview would expedite prosecution or resolve outstanding issues in clear and concise manner; it is encouraged that the undersigned Examiner be contacted. It is preferred that the plurality of annular, concentric, radially spaced recesses be positively claimed in each independent claim, rather than the broad limitation "non-planar surface". It is also preferred that the nipple extending from the center of the weld end at a greater axial distance than the ridges created by said recesses be positively claimed in each independent claim. Lastly, it is suggested that the projecting nipple having a recess occupied with a flux or PM-flux combo packet be positively claimed in each independent claim.

[24] **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

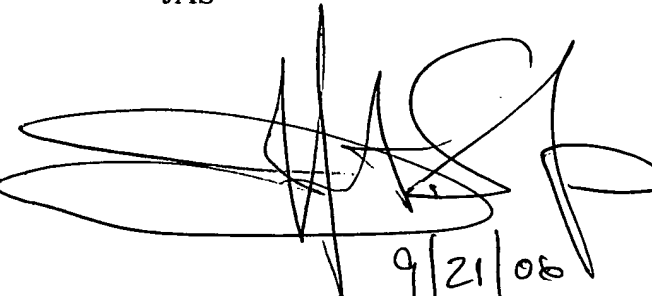
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[25] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Sharp whose telephone number is (571) 272-7074. The examiner can normally be reached 7:00 am - 5:30 pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAS



9/21/08



Katherine Mitchell
Primary Examiner